

REMARKS

With the present submission, claims 1, 5-7, 9, 12, 13, and 16-19 remain pending, and claim 20 is now canceled. Claims 1, 6, 9, 12, 13, 18, and 19 are currently amended. No claims are added.

Claims 12 and 18 stand rejected under 35 U.S.C. § 101 as describing computer programs that are not tangibly embodied in a computer readable medium. MPEP § 2106 is cited.

As shown above, claims 12 and 18 are now amended to begin with the recitation “A computer-readable medium encoded with a computer program” instead of “A computer program,” as was recited at the time the rejection issued. According to MPEP § 2106 (page 2100-13, first column, bottom):

... a claimed *computer-readable medium encoded with a computer program* is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and *is thus statutory [emphasis added]*.

In view of MPEP § 2106, applicants submit that the rejection under 35 U.S.C. § 101 should be withdrawn.

Claims 1, 3, 13, and 19 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Two grounds for the rejection are provided in the Office Action.

Regarding the first grounds, the Office Action suggests that an acceptable response would be to replace “a database configured to be written/read patient data” with –a database able to read and write patient medical data–. Applicants appreciate such suggestion but instead amend in an alternate fashion, as shown above. Applicants submit that this recitation is definite.

Regarding the second ground for the indefiniteness rejection, that is, reciting “an inquiry mail and a reply mail in pairs” in claims 13 and 19,¹ applicants amend this recitation as shown above. Applicants submit that this also recitation is definite.

Accordingly, applicants now request the withdrawal of the indefiniteness rejection.

Claims 1, 5-7, 9, 12, 13, and 16-20 stand rejected under 35 U.S.C. § 103(a) as obvious over Berman et al., U.S. Patent No. 5,995,939, in view of Akers et al., U.S. Patent Application Publication No. 2002/0169637. As shown above, claim 20 is now rejected, thereby rendering its rejection moot. Regarding the remaining claims, applicants respectfully traverse their rejection.

Claim 1, as amended, describes a linkage system in which a first computer has:

- (1) a *database* that stores and retrieves “patient data of patients ... and medical treatment data related to the patient data”;
- (2) an inquiry file creator configured to create an inquiry file having “patient data and medical treatment data both *extracted from the database*” and inquiry contents; and
- (3) an inquiry mail creator configured to create an e-mail being attached to the created inquiry file ...

Claims 5 and 16 depend from claim 1, so they also recite this subject matter.

Applicants acknowledge that Berman et al. discloses the following:

A client makes “service requests” by entering information on an appropriate request screen generated on the client system’s display by resident software. Typical service requests might include the ordering of a blood test for a particular patient, a request for authorization to perform a particular medical procedure, or a request for a quotation on a particular financial investment product. The client system formats a completed service request into a “service

¹ Claim 20, not officially listed on page 2 of the Office Action as rejected as indefinite, is mentioned on page 3, implying that its rejection was intended, also. However, claim 20 is now canceled, thereby rendering any such rejection moot.

request message”, which is e-mailed to the sponsor system of a service provider capable of providing the requested service using the mail server system ...

(Column 2, lines 32-42.) However, regardless of how this excerpt might be interpreted to teach or suggest “patient data,” “medical treatment data,” and an “e-mail being attached to the created inquiry file” as recited in claims 1, 5, and 16, to justify the rejection, the asserted prior art must also teach or suggest “patient data and medical treatment data both *extracted from the database*.”

As explained in the Office Action, the rejection relies on Akers et al. to suggest modifying the Berman et al. system so that it would then have an inquiry file creator configured to create an inquiry file having “patient data and medical treatment data both *extracted from the database*” and inquiry contents. Thus, to support the rejection, a proper reason must be provided for why someone would want to put an order for a blood test into a database and then extract it to create a service request.

However, the only reason provided in the Office Action is that the modified system would provide a further detailed medical record. That is, there is no explanation provided of why someone supposedly would have thought of such a modification beforehand instead of merely appreciating, after learning of the modification, that there would be the benefit of a more detailed report.

Not only is there no cited prior art disclosing that someone would have been thinking of a more detailed report, there is also no explanation in the Office Action of how putting an order for a blood test into a database and then extracting it to create a service request would make the report more detailed than if the database were not used. The modification described in the Office Action would make a more complex process for ordering a service request. However, there is no reason to think that the resulting report would be more detailed, even if it were desired.

Accordingly, the obviousness rejection of claim 1, 5, and 16 has not been properly justified.

Regarding claim 6, this claim describes a computer that has:

- (1) a *database* that stores and retrieves “patient data of patients ... and medical treatment data related to the patient data”;
- (2) an inquiry file creator configured to create an inquiry file having “patient data and medical treatment data both *extracted from the database*” and inquiry contents; and
- (3) an inquiry mail creator configured to create an e-mail being attached to the created inquiry file ...

Claims 7 and 17 depend from claim 6, so they also recite this subject matter. As explained above, the Office Action does not provide a proper explanation of how the asserted prior art supposedly renders obvious claims with this subject matter. Thus, the obviousness rejection of claims 6, 7, and 17 has not been properly justified.

Claim 9, as shown above, now recites that the inquiry file has “patient data and medical treatment data related to the patient data, which are extracted from a database.” As explained above, the asserted prior art does not render obvious a claim reciting this subject matter.

Similarly, claim 12 now also recites the text added to claim 9. Thus, the asserted prior does not render obvious claim 12 for the same reason that it does not render obvious claim 9.

Claim 13, as amended, describes a linkage system in which a first computer has:

- (1) a *database* that stores and retrieves “patient data of patients ... and medical treatment data related to the patient data”;
- (2) an inquiry file creator configured to create an inquiry file having “patient data and medical treatment data both *extracted from the database*” and inquiry contents; and
- (3) an inquiry mail creator configured to create an e-mail ... being attached to the created inquiry file ...

Claim 19, as amended, describes a computer that has these features. Applicants explain above why the asserted prior art does not render obvious claims reciting this subject matter.

Claim 18 has an additional amendment. Specifically, claim 18 now describes a computer-readable medium encoded with a computer program, which allows a computer in a linkage system to function as:

- (1) an inquiry file creator configured to create an inquiry file having "patient data and medical treatment data related to the patient data both *extracted from a database*" ...; and
- (2) an inquiry mail creator configured to create an e-mail being attached to the created inquiry file ...

Applicants explain above why the asserted prior art does not render obvious a claim with this subject matter.


In view of the amendments and remarks above, applicants now request the withdrawal of the obviousness rejection.

Applicants further submit that the entire application is in condition for allowance, and a Notice of Allowability is hereby requested. If the Examiner believes that issues remain unresolved, he is welcome to contact the undersigned.

If necessary, the undersigned authorizes deducting any fees that may be due from Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Joseph L. Felber

Attorney for Applicants

Registration No. 48,109

Telephone: (202) 822-1100

Facsimile: (202) 822-1111

JLF/af Q:\2001\011441\011441 response to 7-5-05 action.doc